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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,787	06/29/2001	Michael F. Moran	MDSP-P01-001	1215
28120	7590	06/28/2004		
ROPE & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624				
EXAMINER LANDSMAN, ROBERT S				
ART UNIT		PAPER NUMBER		
1647				

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,787

Applicant(s)

MORAN ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION***1. Election/Restriction***

A. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to an isolated protein complex, classified in class 530, subclass 402.
- II. Claim 4, drawn to an isolated protein, classified in class 530, subclass 350.
- III. Claim 5, drawn to an isolated polynucleotide, classified in class ⁵³⁶~~435~~, subclass 23.5. *m*
6/24/01
- IV. Claims 6 and 8 in part, drawn to a method for identifying modulators of protein complexes, classified in class 435, subclass 7.2.
- V. Claims 7 and 8 in part, drawn to a method for identifying modulators of GRF2-dependent growth, classified in class 435, subclass 7.2.
- VI. Claim 9, drawn to a method for altering the growth state of a cell using the agent of claim 6, classified in class 435, subclass 7.2.
- VII. Claim 9, drawn to a method for altering the growth state of a cell using the agent of claim 7, classified in class 435, subclass 7.2.
- VIII. Claim 10, drawn to a method for inhibiting Ras-dependent proliferation of a cell using the agent of claim 6, classified in class 435, subclass 7.2.
- IX. Claim 10, drawn to a method for inhibiting Ras-dependent proliferation of a cell using the agent of claim 7, classified in class 435, subclass 7.2.
- X. Claim 11, drawn to a method for inducing differentiation of a cell using the agent of claim 6, classified in class 435, subclass 7.2.
- XI. Claim 11, drawn to a method for inducing differentiation of a cell using the agent of claim 7, classified in class 435, subclass 7.2.
- XII. Claim 12, drawn to a method for reducing the severity of a condition using the agent of claim 6, classified in class 435, subclass 7.2.
- XIII. Claim 12, drawn to a method for reducing the severity of a condition using the agent of claim 7, classified in class 435, subclass 7.2.
- XIV. Claims 13 in part and 14, 15, 15bis, drawn to a method for Ras-dependent proliferation of a cell by inhibiting Skb1, classified in class 435, subclass 7.2.
- XV. Claims 13 in part and 16, drawn to a method for Ras-dependent proliferation of a cell by inhibiting PP2C, classified in class 435, subclass 7.2.
- XVI. Claims 13 in part and 17, drawn to a method for Ras-dependent proliferation of a cell by inhibiting PICIn, classified in class 435, subclass 7.2.

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- XVII. Claim 18, drawn to an engineered cell, classified in class 435, subclass 471.
- XVIII. Claim 19 in part, drawn to a method of detecting aberrant GRF2 expression by measuring gene expression, classified in class 435, subclass 6.
- XIX. Claim 19 in part, drawn to a method of detecting aberrant GRF2 expression by measuring protein stability, classified in class 435, subclass 7.2.
- XX. Claim 19 in part, drawn to a method of detecting aberrant GRF2 expression by measuring complex stability, classified in class 435, subclass 7.2.
- XXI. Claim 20, drawn to a method for Ras-dependent proliferation of a cell by inhibiting Ndr, classified in class 435, subclass 7.2.
- XXII. Claim 21, drawn to a method for Ras-dependent proliferation of a cell by inhibiting localization of Ndr, classified in class 435, subclass 7.2.

B. The inventions are distinct, each from each other because of the following reasons:

Inventions I, II and III are independent and distinct, each from each other, because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged. The polynucleotide of invention III can be used to make a hybridization probe, or can be used in gene therapy as well as to produce the protein of interest. The protein of Group II can be used to make antibodies.

Inventions I and IV are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product MPEP § 806.05(h). In the instant case the complex can be used as antigen for antibody production.

Inventions II and V are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product MPEP § 806.05(h). In the instant case the protein can be used as antigen for antibody production.

Inventions I and II are unrelated to Inventions VI - XXII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

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Inventions IV - XXII are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Furthermore, in order to be fully responsive, in addition to electing a Group, Applicants must elect either one specific protein or nucleic acid sequence to be searched. In the case where the claims are drawn to protein complexes, Applicants must elect one specific protein complex to be searched.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).

Advisory information

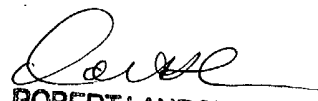
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
June 24, 2004


ROBERT LANDSMAN
PATENT EXAMINER